

REMARKS/ARGUMENTS

The rejections presented in the Office Action dated August 5, 2008, (hereinafter Office Action) and maintained in the Advisory Action dated October 20, 2008, have been considered but are believed to be improper because they are based upon at least two incorrect assumptions. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

Each of the § 103(a) rejections is based, at least in part, upon a combination of the teachings of Kubosawa and Zicker. However, Applicant maintains that these teachings alone, or in combination, do not teach or suggest the claimed prevention of application of a handover algorithm in response to detecting that the current state of a user interface component is inactive. The asserted combination appears to be based upon two statements set forth in the Advisory Action:

1. Kubosawa teaches that if the user interface is inactive, the device will not handover. (page 4, lines 8-9)
2. When the mobile device [of Zicker] becomes inactive and prevented from communicating information, then it is prevented from performing a handover algorithm. (page 3, last 3 lines)

However, both of these statements are incorrect. Thus, the asserted rationale fails to support the rejections rendering each of the § 103(a) rejections improper.

First, Statement 1 is incorrect because Kubosawa teaches that a device will perform handover without any input from a user. Specifically, Kubosawa teaches in paragraph [0032] that when handover is needed and is possible, handover is executed, without any input from the user, by the controller 50. Only when there is a problem in executing the user's stored instructions for handover, is handover executed based on user input in Kubosawa. Thus, contrary to Statement 1, Kubosawa teaches that if no user input is received (the asserted inactive user interface), the device will perform handover.

Second, Statement 1 is directed to executing handover and not to applying/preventing application of a handover algorithm, as claimed. The Advisory Action includes directly contradicting statements regarding whether Kubosawa teaches the claim limitations directed to preventing a handover algorithm. For example, it is re-asserted in the

Advisory Action that “he [Kubosawa] *does specifically disclose that the handover algorithm . . . will be prevented*” (page 2, last sentence of the third paragraph); however, it is also asserted that “he [Kubosawa] does not specifically teach that the handoff algorithm will be prevented” (page 3, lines 13-14). Although, it appears that it is now acknowledged that Kubosawa’s handover algorithm continues to run (page 3, lines 14-15). Since Kubosawa’s algorithm continues to run, Kubosawa fails to teach preventing application of the algorithm, as claimed. Thus, Statement 1 is incorrect (handover is performed without user input) and is unrelated to the claimed limitations (preventing application of a handover algorithm).

Third, Statement 2 is incorrect because Zicker specifically teaches that handover algorithm related tasks are performed while a mobile station is in an inactive state. Notably, the cited portion of Zicker at Col. 14, lines 22-25 states that “[i]t has the effect of preventing mobile station 28 from communicating user information and forcing mobile station 28 to operate in its inactive state” (emphasis added). While the mobile station may be unusable for a user (Col. 14, lines 38-40), it is still operating in an inactive state. As explained previously, Zicker teaches that while operating in an inactive state control channels are scanned to select a best server control channel (task 124 of Fig. 8, Col. 11, lines 18-22). Thus, in direct opposition to Statement 2, Zicker teaches that a handover algorithm is applied when the mobile station is operating in an inactive state.

Since the cited references directly contradict the relied-upon assertions, the rationale for supporting the § 103(a) rejection is incorrect and improper. The references do not teach that which is asserted in the Office and Advisory Actions, and the cited references further fail to teach or suggest at least the claimed prevention of application of a handover algorithm in response to detecting that the current state of a user interface component is inactive. Without correspondence to each of the claimed limitations, each of the § 103(a) rejections is improper.

In order to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); and moreover, “[a]ll words in a claim must be considered in

judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). *See, e.g.*, MPEP § 2143.03. The Examiner appears to have ignored certain claim limitations such as those directed to preventing application of a handover algorithm to detect need for a mobile terminal to change to another channel in response to detecting that a user interface component is in an inactive state, which are not taught by either of the cited references. For example, Kubosawa does not teach preventing application of an algorithm, and Zicker’s mobile station still applies a handover algorithm when in an inactive state, including selection of radio channels. Since neither of the asserted references teaches or suggests at least these limitations, any combination of Kubosawa and Zicker must also fail to teach such limitations thereby rendering the rejections improper. Applicant accordingly requests that each of the rejections be withdrawn.

Dependent Claims 2, 8, 10-12, 19, and 22-28 depend from independent Claims 1, 9, and 21, respectively, and each of these dependent claims also stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the above-discussed combination of Kubosawa and Zicker. While Applicant does not acquiesce to any particular rejections to these dependent claims, including any assertions concerning descriptive material, obvious design choice and/or what may be otherwise well-known in the art, these rejections are moot in view of the remarks made in connection with the independent claims. These dependent claims include all of the limitations of their respective base claims and any intervening claims, and recite additional features which further distinguish these claims from the cited references. “If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious.” MPEP § 2143.03; *citing In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, dependent Claims 2, 8, 10-12, 19, and 22-28 are also patentable over Kubosawa and Zicker.

With respect to the § 103(a) rejections of dependent Claims 3-7, 13-18, and 20 based upon Kubosawa and Zicker in view of GB 2289191 by Motorola; U.S. Patent No. 6,178,388 to Claxton; U.S. Publication No. 2004/0204123 by Cowsky, III *et al.*; U.S. Publication No. 2004/0248594 by Wren, III; and U.S. Patent No. 6,871,074 to Harris *et al.*,

respectively, Applicant respectfully traverses. As discussed above, Kubosawa and Zicker fail to correspond to the limitations of independent Claims 1 and 9 (from which Claims 3-7, 13-18, and 20 depend). The further reliance on these additional teachings does not overcome the above-discussed deficiencies in Kubosawa and Zicker. Thus, the asserted combinations of these teachings with the teachings of Kubosawa and Zicker do not teach each of the claimed limitations of dependent Claims 3-7, 13-18, and 20, and each of the § 103(a) rejections should be withdrawn.

It should also be noted that Applicant does not acquiesce to the Examiner's statements or conclusions concerning what would have been inherent, obvious to one of ordinary skill in the art, obvious design choices, common knowledge at the time of Applicant's invention, officially noticed facts, and the like. Applicant reserves the right to address in detail the Examiner's characterizations, conclusions, and rejections in future prosecution.

Authorization is given to charge Deposit Account No. 50-3581 (KOLS.083PA) any necessary fees for this filing. If the Examiner believes it necessary or helpful, the undersigned attorney of record invites the Examiner to contact the undersigned attorney to discuss any issues related to this case.

Respectfully submitted,

HOLLINGSWORTH & FUNK, LLC
8009 34th Avenue South, Suite 125
Minneapolis, MN 55425
952.854.2700

Date: December 4, 2008

By: /Erin M. Nichols/

Erin M. Nichols
Reg. No. 57,125